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Our Case No. 8371/13

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application:

Robert M. Setbacken et al.

Serial No.: 10/829,546

Filed: April 22, 2004

For: POSITIONAL ENCODER ASSEMBLY

Examiner: Monbleau, Davienne N.

Group Art Unit No. 2878

Mail Stop Appeal Brief-Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450
Sir:

TRANSMITTAL

Attached is/are:

- ☒ Reply Brief (original and 1 copy).
☒ Return Receipt Postcard.

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- ☒ No additional fee is required.
☐ Small Entity.
☐ An extension fee in an amount of \$_____ for a _____-month extension of time under 37 CFR § 1.136(a).
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					Small Entity			Not a Small Entity	
	Claims Remaining After Amendment		Highest No. Previously Paid For	Present Extra	Rate	Add'l Fee	or	Rate	Add'l Fee
Total		Minus			x \$25=			x \$50=	
Indep.		Minus			X105=			x \$210=	
First Presentation of Multiple Dep. Claim					+\$185=			+ \$370=	
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☒ The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925. A copy of this Transmittal is enclosed for this purpose.

Respectfully submitted,

November 16, 2007
Date

John C. Freeman, Esq. (Reg. No. 34,483)

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REPLY BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is in response to the Examiner's Answer mailed September 20, 2007¹.

¹ Since the present Reply Brief is being filed within two months of the mailing date of the Examiner's Answer, the present Reply Brief is timely filed.

I. TEST FOR NON-ANALOGOUS ART

The Examiner at page 12 of the Examiner's Answer replies to Appellants' argument that Leong et al. is directed to non-analogous art. When the Board considers the positions of both the Examiner and Appellants, Appellants point out that the case *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007) may be relevant to the merits of the non-analogous argument.

II. MEANING OF "DISPOSED ON"

On page 12 of the Examiner's Answer, the Examiner asserts for the first time during prosecution of the present application that claim 1's recitation "the lead frame is disposed on the circuit board assembly" is to be broadly interpreted to encompass any lead frame "physically connected and attached to" a circuit board assembly. Appellants traverse such an interpretation. As is well known, patent claims should be construed as they would be by those skilled in the art. *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). To ascertain the true meaning of the claims, it is appropriate to consider the claim language, the patent specification, and the prosecution history. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979, 34 USPQ2d 1321, 1329 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996). In *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) (en banc), *cert. denied*, 546 U.S. 1170 (2006), the court set forth several guideposts that courts should follow when construing claims. The words used in a claim are generally given their ordinary and customary meaning. *Id.* at 1312, 75 USPQ2d at 1326. *Phillips* made clear that "the person of ordinary skill in the art is deemed to read the claim term not only in the

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context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification." *Id.* at 1313, 75 USPQ2d at 1326. Although the claims themselves may provide guidance as to the meaning of particular terms, those terms are part of "a fully integrated written instrument." *Id.* at 1315, 75 USPQ2d at 1327 (*quoting Markman*, 52 F.3d at 978, 34 USPQ2d at 1328). Thus, the *Phillips* court emphasized the specification as being the primary basis for construing the claims. *Id.* at 1314-17, 75 USPQ2d at 1326-28.

The prosecution history also can play an important role in claim interpretation since it helps demonstrate how the inventor and the PTO understood the patent. *Id.* at 1317, 75 USPQ2d at 1329. Because the file history, however, "represents an ongoing negotiation between the PTO and the applicant," it may lack the clarity of the specification and thus be less useful in claim construction proceedings. *Id.*, 75 USPQ2d at 1329.

Phillips rejected any claim construction approach that sacrificed the intrinsic record in favor of extrinsic evidence, such as dictionary definitions or expert testimony. The *Phillips* court condemned the suggestion made by *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 64 USPQ2d 1812 (Fed. Cir. 2002), *cert. denied*, 538 U.S. 1058 (2003), that a court should discern the ordinary meaning of the claim terms (through dictionaries or otherwise) before resorting to the specification for certain limited purposes. 415 F.3d at 1319-24, 75 USPQ2d at 1331-33.

Phillips does not preclude all uses of dictionaries in claim construction proceedings. Instead, the court assigned dictionaries a role subordinate to the intrinsic record. In doing so, the court emphasized that claim construction issues are not resolved by any magic formula. *Phillips* held that a court must attach the appropriate weight to the intrinsic sources offered in support of a proposed claim construction, bearing in mind the general rule that the claims measure the scope of the patent grant.

Based on a review of the claims, Specification and prosecution history of Appellants' application, one of ordinary skill in the art would interpret the phrase "the lead frame is disposed on the circuit board assembly" to mean that the recited lead frame is positioned upon a surface of the circuit board assembly. Such a review would reveal that the "disposed on" phrase has not been given any special meaning beyond what it would ordinarily mean. Based on Webster's Ninth New Collegiate Dictionary, the most relevant definition of "dispose" is "to put in place : set in readiness : arrange."² Based on the above definition, one of ordinary skill would understand "disposed on" to mean "positioned upon." The positional meaning of "disposed" is confirmed by Appellants' own Specification at paragraph 0040 which describes the code disk 18 being "disposed beneath the hub 20." Clearly, "disposed" in this description of paragraph 0040 means that the code disk 18 is positioned below the hub 20 and does

² It is the understanding of the undersigned that 37 C.F.R. § 41.41(a)(2) prevents Appellants from presenting to the Board of Patent Appeals and Interferences ("the Board") the relevant page of the above mentioned dictionary with this Reply Brief. If the undersigned's understanding is incorrect, the undersigned would be willing to send the Board a copy of the relevant page.

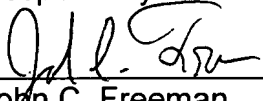
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not suggest any connection or attachment between the code disk 18 and the hub 20.

Since there is nothing in the claims, Specification and prosecution history of Appellants' application to suggest a meaning contrary to the ordinary meaning of "disposed on" outlined above by Appellants, the Examiner's interpretation of the phrase is improper.

Regarding a related matter, based on the Examiner's interpretation of "disposed on", the Examiner asserts at pages 12 and 13 of the Examiner's Answer that should the housing 60 of Leong et al. be interpreted as passing through the planar structure (vertical lines in FIG. 3 of Leong et al.), then the housing 60 would still be "disposed on" the planar structure since it would be connected and attached to "an inner portion of the circuit board (52)." This statement is erroneous on two fronts. First, it is unclear whether circuit board 52 is the same as the planar structure through which the housing is inserted. Second, there is a gap between the inner portion of the planar structure and the exterior surface of the housing 60 as shown in FIG. 3 of Leong et al. Accordingly, there is no attachment between the inner portion of the planar structure and the housing 60.

Respectfully submitted,



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Dated: November 16, 2007